

## REMARKS

Claims 1-7, 16-19, 24, and 26-61 are now in the application. Claims 1, 3, 4, 7, 24, 26, 40, 41, 43, 44, 54, 55, and 56 have been amended. No additional claims or new matter has been added.

Support for the amendment of claims 1, 3, 4, 7, 24, 26, 40, 41, 43, 44, 54, 55, and 56 can be found throughout the application as originally filed, for example, see Figs. 9 through 20 and paragraphs [0053] and [0070].

### Specification

Per the request of the Examiner, the specification was amended to add the patent number of the parent case.

### Objection

Applicant has considered the Examiner's objection with respect to claim 24. Applicant has amended for reasons independent of patentability.

### 35 USC 112, First Paragraph

Claims 1-7, 16-19, 24, 32-44, 46-50, and 54-59 has been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Although Applicant respectfully disagrees with the examiner, claims 1 and 40 have been amended to further prosecution. Accordingly, the claims meet the requirements of 35 U.S.C. § 112, first paragraph.

35 USC 112, Second Paragraph

Claims 3, 17, 19, 41, 44, 47, and 55 have been rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim.

Referring to the rejection of claim 3, Applicant has amended claim 3 to further prosecution and for reasons independent of patentability.

With reference to the rejection of claims 17 and 19, the Applicant respectfully disagrees with the Examiner's statements that the claims "require the medical implant to be a needle" and that "the needle [is] merely an implement for driving the suture through tissue." Office Action Dated March 24, 2010, Pages 4-5. In response to the Examiner's statements, the medical implant may include but is not required to be a needle and the medical implant may have limitless applications. For examples, an anchor is disclosed in at least Fig. 1-3 and paragraphs [0018]-[0020] and [0039]-[0046] and an implant is disclosed in at least Figs. 18-20 and paragraphs [0036], [0037], [0067], and [0068].

Referring to the rejection of claim 41, "a magnetic field generator" is recited in claim 40 from which claim 41 depends thereby providing antecedent basis.

With reference to the rejection of claims 44 and 55, these claims were amended to recite "a medical implant" thereby providing antecedent basis.

Referring to the rejection of claim 47, Applicant disagrees with the Examiner's implication that a claim 1 requires both members to include an electromagnet. A magnetizable material may include but is not required to include an electromagnet. Therefore, claim 47, by reciting "first

and second tissue engaging members include electromagnets”, properly narrows the scope of claim 1.

Accordingly, the claims meet the requirements of 35 U.S.C. § 112, second paragraph.

### 35 USC 102

In the first paragraph on page five of the Office action, Claims 1-3, 5, 6, 24, 32, 33, 34, 37, 39, 40-42, 44, 46-50, 55, 57, and 59 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent No. 6,699,240 B2 to Francischelli (“Francischelli”).

As an initial matter, Francischelli was filed December 12, 2001, which is after the priority date of this application, but claims the benefit of a provisional application filed April 26, 2001. Applicant expressly reserves the right to swear behind Francischelli. For all embodiments in Francischelli with “magnetically attracting ... first and second components”, the embodiments require either handles 12 and 14 or handles 212 and 214. Nowhere does Francischelli disclose the claimed elements of claims 1 and 40 including “an elongate body having a non-expandable portion and a magnetically manipulatable distal end”. Because Francischelli fails to teach every element the claims, this reference does not anticipate the claims. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection.

### 35 USC 103

#### Francischelli

In the second paragraph of page 7, claim 38 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Francischelli. The discussion of Francischelli’s failure to teach the elements of claim 1 is hereby incorporated by reference. Because Francischelli fails to disclose every

element required by claim 1, this reference does not obviate claim 1 from which claim 38 depends.

Francischelli in view of Wilkinson

In the last paragraph of page 7, claim 43 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Francischelli as applied to claim 40 above, in view of Wilkinson (U.S. Patent No. 3,577,991).

Referring to the proposed combination of Francischelli and Wilkinson, this proposed combination also fails to disclose every element of claim 40 including “an elongate body having a non-expandable portion and a magnetically manipulatable distal end”. Furthermore, proposed combination merely provides “a plain pin or axle for the hinge can be held in place by the shields 15 on both sides of the members or legs” at Wilkinson, column 2, line 39, but fails to disclose a shield connected to a tissue engaging member. Therefore, claim 40, from which claim 43 depends, is patentable over the proposed combination.

Fukuda and Francischelli

In the second paragraph of page 8, claims 4, 7, 16-19, 35, 36, 54, 56, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,824,009 to Fukuda et al. (“Fukuda”) and Francischelli.

Referring to the combination of Fukuda and Francischelli, Fukuda mentions a “needle body 3a made of a magnet” and “needle receiver 5 made of a magnetic material”, but merely teaches use of a magnet to move a needle relative to a needle receiver. Nowhere does the proposed combination disclose the elements of claims 1 and 40 including “an elongate body having a non-expandable portion and a magnetically manipulatable distal end”. Because the proposed

combination fails to teach every element the claims, the Applicant respectfully requests the Examiner to withdraw this rejection.

#### Terminal Disclaimer

Claims 1-7, 16-19,24,32-36,38,44,49,50,54,55, and 58 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-26 of U.S. Patent No. 6,719,765 82. Furthermore, claims 37, 39-43, 46, 49, 50, 56, 57, and 59 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-26 of U.S. Patent No. 6,719,765 82 in view of U.S. Patent No. 3,577,991 (Wilkinson). Applicant requests that this rejection be held in abeyance until all other issues regarding patentability are resolved. Should the claims be amended during prosecution, the amended claims may not require a terminal disclaimer. Alternatively, should a conflict remain, Applicant will consider the filing of a timely terminal disclaimer.

#### Conclusion

In view of the foregoing, reconsideration and allowance of claims 1-7, 16-19, 24, 26-61 are solicited.

A fee for an RCE and the appropriate extensions are enclosed herewith. If a further extension of time for this paper is required, petition for extension is herewith made.

Appl. No. 10/784,401  
Amendment Dated April 25, 2011  
RCE after March 24, 2010 Notice of Appeal

No other fees are believed to be due for this submission. However, please charge any required fee (or credit any overpayments of fees) to the Deposit Account of the undersigned, Account No. 503410 (Docket No. 780-A04-002-1).

Respectfully submitted,

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